UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,747	06/28/2001	Tatsuo Nomura	1035-332	3643

			EXAMINER
23117	7590	01/13/2006	BARQADLE, YASIN M

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has

been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37

CFR 1.114. Applicant's submission filed on October 13, 2005 has been entered.

Response to Amendment

2.   The amendment filed on October 13, 2005 has been fully considered but are moot in

view of the new grounds of rejection.

Claims 1-32 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki (U.S. Patent Number **5,859,969**, hereinafter "Oki") in view of Takahashi et al (U.S. Patent Number 6,195,432, hereinafter "Takahashi"). Oki discloses a remote installation system and method. Oki shows:

In referring to claim 1 and 8,

- Transmitting an operating environment of the user system from the user system via the network to the server before supplying the program:

"The circumstance information informing **unit obtains circumstance information relating to software operation circumstances in the terminal equipment and informs the distributing center** *of them. " (Oki,* col. 2. lines 33-36 and col. 8, lines 36-65)

- Judging whether the program is operable or not in the operating environment, and transmitting a result of the judgment from the server via the network to the user system: *"The circumstance checking unit compares the circumstance* **information** *received from the circumstance* **information informing unit** *with that of the target software to check whether or not they are compatible, and informs the installing unit of the check result thus obtained. The installing unit decides whether or not the target software is to be distributed* **and** *if so, it determines a software* **distributing method, in response to the check result. " (Oki,** col. 2, lines 37-44).

- Executing the program on the user system after the program is supplied from the server and installed on the user system to thereby **confirm proper operation** of the program: The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

Although Oki shows substantial features of the claimed invention, he does not explicitly show requesting payment for a program after its proper operation confirmed.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Oki, as evidenced by Takahashi USPN. (6195432).

In analogous art, Takahashi whose invention is about a software distribution system and software utilization scheme for improving security and user convenience, disclose purchasing software only when a user is satisfied with the trial use of the software (col. 22, lines 2-20).

Giving the teaching of Takahashi, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Oki by employing the system of Takahashi so that users can purchase software/programs of their interest after it is tried and verified by its operation without a need of any cooling off period.

In referring to claim 2,

- Displaying the result of the judgment as to whether the program is operable or not in the operating environment of the user system:

   "The installing menu display unit displays plural methods of installing the target software." (Oki, col. 3, lines 45-46)

In referring to claim 3 and 9,

- Transmitting an order for the program from the user system via the network to the server when the program is judged to be operable:

   Oki, Fig. 4 shows selecting a program S12, checking if the program is operable at S14, Fig. 5 shows transmitting the selected program at S18

In referring to claim 4 and 10,

- Generating a program list made up of programs which can be supplied from the server, transmitting the program list from the server via the network to the user system; selecting a program from the program list:

   "When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

In referring to claim 5,

- Generating by the server a program list made up of programs which can be operated in the operating environment of the user system; transmitting the program list from the server via the network to the user system; selecting a program from the program list: *Oki, col. 5, lines 14-20* (see **full quote above**)

In referring to claim 6 and 11,

- Storing the result of judgment as data of the user system in the server when the program is judged to be inoperable:
   Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 7,

- Expanding functions of the user system when a program supplied from the server via the network to the user system is installed:

  Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system

In referring to claim 12,

- Said user system includes operating environment judging means for judging an operating environment of the user system, and before having a program supplied, transmits the judged operating environment via the network to the server:

  Oki, col. 2. lines 33-36 (see full quote above)

- Said server includes operation judging means for judging whether the program is operable or not in the received operating environment, and transmits a result of judgment as to whether the program is operable or not via the network to the user system: *Oki, col. 2, lines 37-44* (see full quote above)

- Said user system is operable to Execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

As to requesting payment for a program after its proper operation confirmed see the rejection above in claim 1 and 8.

In referring to claim 13,

- Operation input means to be operated by a user, said user system is activated in response to operation on the operation input means:

  "When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

- Display means for displaying data; displaying the result of judgment given by the operation judging means of the server on the display means:

  Oki, col. 3, lines 45-46 (see full quote above)

- The user system transmits the operating environment judged by the operation environment judging means via the network to the server.

  Oki, Fig. 3 shows judging the operation environment at steps S1 and S2, and then _ transmitting them at step S3

In referring to claim 14,
- Said user system orders the program to the server when the result of judgment received from the server indicates that the program is operable:

  Oki, Fig. 4 shows the user orders the program after the judgment (circumstance check)

In referring to claim 15,

- Said server further includes storing means for storing data of the user system: Receiving user **data and** running a script on said user **data** (Oh, Fig.4, **S14 and 40)** inherently implies a storing means to store said user data

In referring to claim 16,
Said user system expands its functions when a program supplied via the network from the server is installed.
Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system

In referring to claim 17,
- Said user system is any of a personal computer, a portable terminal, and a complex digital image forming apparatus:

  Oki, Fig. 2 shows the user system is a portable terminal

In referring to claim 18,
- Said server further includes list generating means for generating a program list made up of programs which can be supplied to the user system, and transmits the program list via the network to the user system; said user system displays the program list on the display means, and selects a program from the program list according to operation on the operation input means:

  Oki, *col.* 5, *lines 14-20* (see full quote above)

In referring to claim 19,

- Said server further includes list generating means for generating a program list made up of programs which are operable in the operating environment of the -.user system; transmits the program list via the network to the user system, and said user system displays the program list on the display means and selects a program from the program list according to operation on the operation input means:

    Oki, Fig. 4 shows requesting a list from the server S10, generating a list at the server, receiving and displaying the list S12, and selecting a program from the list S12

In referring to claim 20,
Said server stores the result of judgment by the operation judging means when the program is judged to be inoperable:
Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 21,

- Operating environment judging means for judging an operating environment of the user system; user-side communication means for transmitting data to and receiving data from the server via the network:
    *Oki, col. 2. lines **33-36** (see* full **quote above)**

- Server-side communication means for transmitting data to and receiving data from the user system via the network; operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side communication means:
    Oki, col. 2, lines 37-44 and col. 8, lines 36-65 (see full quote above)

- Said user system is operable to execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oh is to **download** new software to be executed on the client.
Executing the software is inherently implied in the system of Oki (See col. 8, lines 36-65)
As to requesting payment for a program after its proper operation confirmed see the rejection above in claim 1 and 8.

In referring to claim 23,

- Transmitting by a user system an order for a program via a network to a server,

  Oki, Fig 3 shows selecting software at step S12

- Receiving the program in response to be order from the server via the network;

  Oki, Fig. 5 shows receiving the program at S17 in response to the selection

- Executing the program to thereby confirm proper operation thereof; and transmitting a notification of operation confirmation via the network to the server so as to allow the server to confirm an operation state of the program:

  Oki, Fig. 5 shows the confirming of **decompression, moving/re-naming** files and registration, signifying the operation of the program

In referring to claim 24,

- User-side operation judging means for executing the received program, thereby confirming proper operation of the program; operation confirmation notification transmitting means for, upon the user-side operation judging means executing the received program, transmitting a notification of operation confirmation to the server so as to allow the server to confirm the proper an operation state of the program:

  Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration, signifying the operation of the program (see also col. 8, lines 36-65)

In referring to claim- 26,

- A computer-readable recording medium having a program for executing the program receiving method of claim 1 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki

In referring to claim 27,

- A computer-readable recording medium having a program for executing the program receiving method of claim 23 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of

Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Platt (U.S. Patent

Number **5,421,009, hereinafter "Platt")** in view of Takahashi et al (U.S. Patent Number 6,195,432, hereinafter "Takahashi"). **Platt discloses a method of remotely installing software directly from a central computer. Platt shows,**

In referring to claim 21,

Operating environment judging means for judging an operating environment of the user system:
Platt, Fig. 8 shows checking the operating system level at step 816
- User-side communication means for transmitting data to and receiving data from the server via the network:

    Platt, Fig. 8 shows a bi-directional connection 106 from a server 108 to a client 110 at step

- Server-side **communication** means for transmitting data to and receiving data from the user system via the network:

    Platt, Fig. 8 shows a bi-directional connection 106 from a server 108 to a client 110 at step

- Operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side **communication** means:

"In the same **manner** as **block 812 checked** the **hardware** and limits the installation to certain types of hardware, block 816 limits the installation to certain types and levels of operating systems. " (Platt, col. 6, lines 32-36)

    Platt, Fig. 8 shows checking the operating system level at step 816 and generating an error message if it won't operate on the user system

- Said user system is operable to Execute the program on the user system after the **program** is supplied from the server and installed on the user system to thereby confirm operation of the program:

    The purpose of the system of Platt is to. **download** new software to be executed on the client. Executing the software is inherently implied in the system of Platt

Although Platt shows substantial features of the claimed invention, he does not explicitly show requesting payment for a program after its proper operation confirmed.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Platt, as evidenced by Takahashi USPN. (6195432).

In analogous art, Takahashi whose invention is about a software distribution system and software utilization scheme for improving security and user convenience, disclose purchasing

software only when a user is satisfied with the trial use of the software (col. 22, lines 2-20).
Giving the teaching of Takahashi, a person of ordinary skill in the art would have readily
recognized the desirability and the advantage of modifying Platt by employing the system of
Takahashi so that users can purchase software/programs of their interest after it is tried and
verified by its operation without a need of any cooling off period.

Claim Rejections - 35 UTSC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this
Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the
>
> Invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of Alexander
et al. (U.S. Patent Number 6,134,593, hereinafter "Alexander").

In referring to claim 22, Oki shows substantial features of the claimed invention including: server-
side operation judging means for confirming an operation state of the program in the user system:
Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration,
signifying the **operation of the program.**

Although Oki shows substantial features of the claimed invention, he does not explicitly show

requesting payment for a program after its proper operation confirmed.

Nonetheless, this feature is well known in the art and would have been an obvious modification

of the system disclosed by Oki, as evidenced by Takahashi USPN. (6195432).

In analogous art, Takahashi whose invention is about a software distribution system and

software utilization scheme for improving security and user convenience, disclose purchasing

software only when a user is satisfied with the trial use of the software (col. 22, lines 2-20).

Giving the teaching of Takahashi, a person of ordinary skill in the art would have readily

recognized the desirability and the advantage of modifying Oki by employing the system of

Takahashi so that users can purchase software/programs of their interest after it is tried and

verified by its operation without a need of any cooling off period.

In referring to claim 25, Oki shows substantial features of the claimed invention including

- Server-side operation judging means for confirming an operation state of the program in the
  user system; and user-side operation **judging** means for confirming operation of the
  program; and operation confirmation notification transmitting means for transmitting a
  notification of operation confirmation to the server so as to allow the server to confirm an
  operation state of the program:
  Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and
  registration, signifying the operation of the program

- where the program **supply** system and the **program** receiving **apparatus** are **connected to
  each other via a network:**
  Oki, Fig. 2 **shows** the **program supply** system **21 and** the program receiving **apparatus 23**
  are connected to each other via a network 22

Although Oki shows substantial features of the claimed invention, he does not explicitly show

requesting payment for a program after its proper operation confirmed.

Nonetheless, this feature is well known in the art and would have been an obvious modification

of the system disclosed by Oki, as evidenced by Takahashi USPN. (6195432).

In analogous art, Takahashi whose invention is about a software distribution system and

software utilization scheme for improving security and user convenience, disclose purchasing

software only when a user is satisfied with the trial use of the software (col. 22, lines 2-20).

Giving the teaching of Takahashi, a person of ordinary skill in the art would have readily

recognized the desirability and the advantage of modifying Oki by employing the system of

Takahashi so that users can purchase software/programs of their interest after it is tried and

verified by its operation without a need of any cooling off period.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of

Thomas (U.S. Patent Number 4,446,519, hereinafter "Thomas"). Although Oki shows substantial

features of the claimed invention, Oki does not show sending notification to the server when the

program is executed. Nonetheless this feature is well known in the art and would have been an

obvious modification to the system disclosed by Oki as evidenced by Thomas.

In analogous art, Thomas discloses a method and apparatus for providing security for

computer software. Thomas Fig. 1 shows sending a message to a security device after the program

begins execution.

Given these teachings, a person of ordinary skill in the art would have readily recognized the

desirability and advantages of modifying the system of Oki so as to notify the server when the

program is operating, such as taught by Thomas, in order to provide security for said program.

Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (U.S.

Patent Number 6,073,214, hereinafter "Fawcett") in view of Merkle et al. (U.S. Patent Number

6,330,549, hereinafter "Merkle").

In referring to claim 31, Fawcett shows substantial features of the claimed invention, including:

- Sending to the server operating environment data of the user system:

  Fawcett, Fig. 4A, step 70

- Receiving from the server a list of programs that is generated based on the operating

  environment data:

  Fawcett, Fig. 4A, step 76

- Sending to the server a request for one of the programs selected from the list; receiving the

  selected program from the server, installing the received program:

  Fawcett, Fig. 4A, step 94

Executing the program to confirm its operation:
The purpose of the system of Fawcett is to download new software to be executed on the client.
Executing the software is inherently implied in the system of Fawcett

However, Fawcett does not show sending to the server a notification regarding the confirmation of operation. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Fawcett as evidenced by Merkle.

In analogous art, Merkle discloses protected shareware. Merkle shows requesting usage authorization while the program is running (Meride, Fig. 3).

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Fawcett so as to send to the server a notification regarding the confirmation of operation, such as taught by Merkle, in order to allow the server to extend the **functionality** of the software.

In referring to claim 32, Fawcett in view of Merkle shows,

- Receiving a request for payment for the program from the server after the sending of notification:

   Merkle Figs. 3-5 show running the program (Fig. 3), then requesting extended functionality (Fig. 3), billing the user (Fig. 5), and finally providing extended functionality (Fig. 3).

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained form the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either private PAIR or public PAIR system. Status information for

unpublished applications is available through private PAIR only. For more information about

the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153

KRISNA LIM
PRIMARY EXAMINER